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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,459	11/21/2001	Mariko Egawa	TOS-125-USA-D	2290

7590 02/27/2003

TOWNSEND & BANTA
Suite 500, #50028
1225 Eye Street, N.W.
Washington, DC 20005

EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 02/27/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/989,459

Applicant(s)

EGAWA ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 13-16 and 20-37 is/are pending in the application.
- 4a) Of the above claim(s) 32-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 13-16 and 20-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-4, 13-16, 20-37 are pending. Claims 32-37 are withdrawn from consideration, as they are directed to non-elected subject matter.

Applicant's request for reconsideration of the finality of the rejection of the last Office action filed 2/13/02, Paper No. 9, is persuasive and, therefore, the finality of that action is withdrawn. Since the instant claims are fully supported by the disclosure of parent Application No. 09/147,293, the instant claims are afforded the priority date of Application No. 09/147,293. Therefore the Egawa reference applied under 35 USC 103 to reject the instant claims in the previous Office Action is improper.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 13-16, 20, 25, 30, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over N'Guyen et al. (5,023,235) in view of Katsumata et al. (5,601,806).

The instant invention is directed toward a method of applying to the skin a composition comprising a sulfur containing amino acid and one or more ingredients selected from the group consisting of metabolic intermediates of sulfur containing amino acids, tannin, and vitamin C and derivatives thereof.

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N'Guyen et al. exemplify a skin cream for application to the skin, comprising 0.5% ascorbic acid, 0.05% citric acid, and 0.1% glutathione. The composition is directed to antioxidant compositions. The reference lacks thiotaurine. See Col. 5, lines 45-60.

Katsumata et al. teach methods for scavenging active oxygen compounds and preventing damage from ultra violet B rays using taurine analogs. Thiotaurine and hypotaurine are taught as taurine analogs. Exemplified is a cream composition for application to the skin comprising 1% thiotaurine and 0.5% hypotaurine. See abstract; Col. 12, line 50-Col. 14, line 60.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the thiotaurine and/or hypotaurine taught by Katsumata et al. to the composition of N'Guyen et al. because of the expectation of achieving a synergistically effective anti-oxidant composition and because it is obvious to combine two compositions taught by the prior art to be useful for the same purpose to form a third composition that is to be used for the very same purpose. In re Kerkoven, 205 USPQ 1069 (CCPA 1980).

The claims are directed to a method of applying a composition comprising glutathione, hypotaurine, thiotaurine, and citric acid to the skin. The Examiner respectfully points out that a chemical composition and its properties are inseparable. Therefore, if the prior art arrives at the same composition, the properties Applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not possess the same properties as instantly claimed product. The prior art teaches application to the skin of compositions containing the same components as instantly claimed, which must treat

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environmental stress as instantly claimed. Applicant has not provided any evidence of record to show that the prior art compositions do not exhibit the same properties as instantly claimed.

Claims 21-24, 26-28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over N'Guyen et al. in view of Katsumata et al. as applied to claims 1-4, 13-16, 20, 25, 30-31 above, and further in view of Tominaga (5,747,049).

N'Guyen et al. and Katsumata et al. are applied as discussed above. The references lack tannic acid and preferred forms of vitamin C.

Tominaga teaches cosmetic compositions for treating aging and the harmful effects of UV rays. Tannic acid is taught as an active agent in such a composition. L-ascorbic acid phosphate and DL-alpha-tocopherol-L-ascorbic acid phosphate diester dipotassium are disclosed as vitamins that inhibit the signs of aging. See abstract; Col. 6, lines 47-58.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add tannic acid, as taught by Tominaga, to the composition of the combined references because of the expectation of achieving a composition with enhanced effects against aging and that provides protection from the sun, which can cause free radicals.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for

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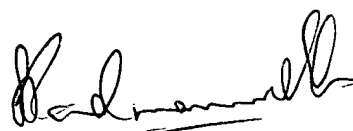
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the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw

February 26, 2003



SREENI PADMANABHAN
PRIMARY EXAMINER

2/27/03